

REMARKS

After entering the above amendments, claims 78-80, 83-85, and 87-142 will be pending. Reconsideration and allowance of the above-referenced application are respectfully requested in light of the above-marked amendments and the foregoing remarks. The undersigned renews his request for an interview in this matter and would be happy to discuss the current response on a formal or informal basis with the examiner.

The Office has rejected claim 132 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 132 has been amended to more specifically define the means-plus-function features.

Claims 78-80, 83-85, 87-97, 99-107, 110-112, 114-124 and 126-142 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Publication No. 2003/0069869 to Gronau et al. (hereinafter "Gronau"); and in view of Zarb (hereinafter "Zarb") U.S. Publication No. 2004/0039619. Claims 98 and 125 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gronau in view of Zarb, and further in view of U.S. Publication No. 2002/0147626 to Zagotta et al. (hereinafter "Zagotta"). These rejections are respectfully traversed.

For a proper rejection under 35 U.S.C. § 103(a), the Office "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness" and must therefore present "a clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP § 2142. An obviousness rejection "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP § 2141 quoting *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1386, 1385 (2007). This rationale must include a showing that all of the claimed

elements were known in the prior art and that one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, to produce a combination yielding nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395. MPEP §2141.02 further notes that “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The rejection over the cited references fail to satisfy this burden with regards to the currently pending claims as each and every element of the specifically recited claims is not disclosed or taught by such art.

Gronau relates to computer-implemented methods and systems for assisting the process of strategic planning. According to Gronau, the process provides for application of a computer-based expert system in the articulation of vision, development of goals, detailing of objectives and establishment of action plans for variety of domains applicable to individuals, groups, institutions or businesses. With Gronau, resulting integrated action plans are automatically assessed for realism, consistency and alignment with consideration to available resources (enablers and constraints) and pre-established rules, axioms, policies and values. Gronau also states that planning can be accomplished by a single planner, as a collaborative effort by plurality of users, as a decision-making and simulation tool for assessing alternatives or for training purposes.

Zarb relates to a system, method, apparatus, means, and computer program code for analyzing an organization. According to Zarb, a method for analyzing an organization may include allowing a user to select a benchmarking mode to analyze a organization, determine the information needed for the selected benchmarking mode, and provide information regarding the

organization determined in accordance with the selected benchmarking organization. In some embodiments of Zarb, information regarding the organization may include information regarding a strategy that may be implemented by the organization, a role associated with the strategy, a process associated with the role, and an asset associated with the process.

Zagotta describes a system for strategy management within an organization. According to Zagotta, the system includes a shared strategic plan, and a first processing device controllable by a user having a user identification. The first processing device includes a first communications module operable to communicate the user identification, to communicate a request to receive at least a portion of the shared strategic plan, and to receive the requested portion after communicating the user identification and the request. The system further includes a second processing device. The second processing device includes an administration module operable to validate that the user has permission to receive the requested portion, and a communications module. The communications module is operable to receive the user identification from the first processing device, and to communicate the requested portion to the first processing device when the user identification is valid.

All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, if the cited references fail to disclose or at least fairly suggest each specific and explicit limitation of the claimed subject matter, the Office can present a valid *prima facie* case for obviousness under 35 U.S.C. §103 only by presenting a convincing line of reasoning as to why one of ordinary skill in the art at the time of conception of the instantly claimed subject matter would have found the claimed invention to have been obvious in light of the teachings of the references. See *e.g.* MPEP §706.02(j) citing *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). It is

respectfully submitted that the interpretation of the cited references is overly broad and that certain features recited in the claims are not accurately interpreted (or do not have a basis in the cited references).

As an example, Gronau fails to disclose strategies that represent a set of rules specifying a course of action to take for a decision out of one or more decisions. The passage in paragraph 75 states something different, namely that an end objective is known and a strategy for reaching such objective is devices. This differs from a strategy as defined in the application that is pre-defined and has multiple courses of action which can be undertaken (via a plurality of decisions, etc.). The undersigned welcomes input from the examiner if he feels that this feature can be further clarified. Similarly, the independent claims explicitly describe a data request and reception module that includes a data dictionary. Simply stating, as is the case with Gronau, that rules based programming is used, does not disclose a data dictionary as recited in the claims. Similarly, rules based programming does not necessarily imply the transformation and cleansing module for verifying the data and transforming it into a form that is used to build quantitative models. Therefore, on this basis alone, the deficiencies of Gronau would have prevented the skilled artisan from arriving at the claimed subject matter.

As accurately characterized, Gronau fails to disclose, at least, the recited intermediate variables that encapsulate dependent variables, independent variables, as well as decision keys. The office action also points out other features which are clearly not disclosed by Gronau and Zarb was cited in this regard. However, Zarb, and in particular the cited par. 68 of Zarb simply states that benchmarking nodes can be used which include pre-defined formulas for use in analyzing strategies. There is no suggestion that such benchmarking nodes are intermediate variables nor that there is an overall decision model that formalizes relationships among all of

the decisions, the decision keys, the intermediate variables, value variables, as well as constraint variables. As stated above, each and every word in a claim must be considered when judging patentability. The current rejection simply takes an overly broad interpretation of Zarb to cover very specifically recited features.

Notwithstanding the above, the independent claims have been amended to further clarify the differences with regard to the independent variables. In particular, each independent claim was amended to recite: “each intermediate variable containing a model that maps values of nodes it depends on to values it can take on, each intermediate variable encapsulating a predictive model that with a dependent variable and independent variables” (for support, see, *inter alia*, specification par. 432). Such amendments even further differentiate the cited references.

Accordingly, the independent claims should be allowable. Lastly, as the independent claims are nonobvious under 35 U.S.C. § 103, then the claims depending therefrom are also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, all claims should be allowable.

Conclusion Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated

in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 35006-556F01US.

Respectfully submitted,

Date: April 6, 2011

/ck3/
Carl A. Kukkonen, III
Reg. No. 42,773

Address all written correspondence to
Customer No. 76615
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
Phone: 858.314.1500
Fax: 858.314.1501